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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,509	12/18/2003	Frederick W. Ryan Jr.	F-730-O1	1508

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EXAMINER

VETTER, DANIEL

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,509	Applicant(s) RYAN ET AL.	
	Examiner DANIEL P. VETTER	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/17/2008, 3/18/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the Claims

1. Claims 14-32 were previously pending in this application. Claims 1 and 21 were amended in the reply filed March 17, 2008. Claims 14-32 are currently pending in this application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on March 17, 2008 has been entered.

Response to Arguments

3. Applicant's arguments with respect to the rejections made under § 102 due to the lack of a teaching in Montgomery of a reprint request have been fully considered but are moot in view of the new grounds of rejection.

4. Applicant's argument that Montgomery is not sufficient to teach a negative print success indicator is not persuasive. Montgomery describes "a misprint scenario where an end user attempts to print an Express Mail label and the printing process fails in some way even though the postage was issued." ¶ 0168. The negative print success is noted for refund purposes, and if that label subsequently appears in the mail stream a fraud investigation is launched. ¶ 0176. The claims do not limit the broadly recited "negative print success indicator" to any particular type and thus they read on the descriptions in Montgomery. Additionally, examiner maintains any print success indicator would necessarily require that it is in response to either a failed printing or a successful printing, as these are the only two possible outcomes of a printing attempt.

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5. Applicant's argument that a "postage vendor ID" cannot fairly be taken alone to teach a "permit number" is noted. The rejection now more clearly demonstrates that Montgomery is sufficient to teach a permit number in the form of "a postage vendor ID and user account number" (§ 0083), while also teaching an identifier as a "meter or account ID" (§ 0140) and that an indicia can include a "Certificate Serial Number" (Table 2).

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 14-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claims 14-32 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being

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transformed (e.g., by identifying the product or material that is changed to a different state). While these claims are tangentially related to the printing of physical shipping labels, the positively recited indicators and other elements are only "associated" with the required machines and materials. As such, they concretely identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 14-18, 21-25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery, et al., U.S. Pat. Pub. No. 2003/0220887 (Reference A of the PTO-892 part of paper no. 20070502) in view of Whitehouse, et al., U.S. Pat. No. 6,687,684 (Reference A of the attached PTO-892).

12. As per claims 14 and 21, Montgomery teaches a method for detecting fraud by a user of a shipping label [and transportation item] having an identifier comprising: receiving a print success indicator associated with a print request for the shipping label having a first identifier [and of the identifier that is associated with the transportation item] (§ 0127), wherein the print success indicator comprises a response or a default indication if no response is received within an allocated response time period (§ 0168); receiving a list of identifiers representing items processed by [and used in] a shipping stream (§ 0083); if the print success indicator is negative, reporting a potential fraud if the first identifier is present in the list of identifiers (§§ 0168, 0176); and if the print success indicator is positive, reporting a potential fraud if the first identifier is present at least twice in the list of identifiers (§ 0109).

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Although Montgomery teaches that shipping labels are known to be reprinted in the event of a failure (§ 0020), it does not teach the particular request involved is a reprint request rather than a simple print request; which is taught by Whitehouse (Abstract). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to modify Montgomery to support the event that user needs to reprint the same unused postage after an error has occurred (as taught by Whitehouse, col. 1, lines 53-59, col. 2, lines 7-12). Moreover, since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the reprinting request in Whitehouse for the print request taught in Montgomery. The combination would have been prima facie obvious because it is merely the simple substitution of one known element for another that could be implemented through routine engineering to produce only predictable results.

13. As per claims 15 and 22, Montgomery in view of Whitehouse teaches the methods of claims 14 and 21 as described above. Montgomery further teaches the list of identifiers is received periodically (§ 0117).

14. As per claims 16 and 23, Montgomery in view of Whitehouse teaches the methods of claims 14 and 21 as described above. Montgomery further teaches the list of identifiers comprise identifiers recognized for a period of time (§ 0086).

15. As per claim 17, Montgomery in view of Whitehouse teaches the method of claim 15 as described above. Montgomery further teaches the list of identifiers is received daily (§ 0117).

16. As per claims 18 and 25, Montgomery in view of Whitehouse teaches the methods of claims 16 and 23 as described above. Montgomery further teaches the list of identifiers comprises identifiers recognized during the prior one year (§ 0086). Montgomery does not teach the time period is the prior six months. However, it would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the time period is the prior six months because this is merely an

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optimized range of time. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

17. As per claim 24, Montgomery in view of Whitehouse teaches the method of claim 22 as described above. Montgomery further teaches the identifiers comprise identifiers from a plurality of sets of identifiers (§ 0087).

18. As per claim 28, Montgomery in view of Whitehouse teaches the method of claim 21 as described above. Montgomery further teaches the transportation item is an item selected from the group: envelopes, post cards, postage labels, labels and packages (§ 0081).

19. As per claim 29, Montgomery in view of Whitehouse teaches the method of claim 21 as described above. Montgomery further teaches the identifiers are selected from at least one set of identifiers wherein the set of identifiers includes one or more from the group: planet codes, delivery confirmation numbers, IBI indicia, identifiers including the combination of a piece count and permit number, and identifiers including the combination of a meter number and ascending register (§ 0095).

20. As per claims 30-32, Montgomery in view of Whitehouse teaches the method of claim 14 as described above. Montgomery further teaches the identifiers are selected from at least one set of identifiers comprising planet codes (§ 0140); identifiers including the combination of a meter number and ascending register (§§ 0008, 0083); and identifiers including the combination of a piece count and permit number (§ 0083; examiner is interpreting a postage vendor ID and user account number as a permit number; see also § 0097 (account-specific piece count), § 0140 (meter or account ID) and Table 2).

21. Claims 19, 20, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery, et al. in view of Whitehouse, et al. as applied to claims 19 and 26 above, further in view of McFiggans, et al., U.S. Pat. No. 6,032,138 (Reference B of the PTO-892 part of paper no. 20070502).

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22. As per claims 19 and 26, Montgomery in view of Whitehouse teaches the methods of claims 15 and 22 as described above. Montgomery does not teach reporting a potential fraud if an identifier having a successful print indicator is not recognized within an expected package period; which is taught by McFiggans (col. 2, lines 56-60). It would have been prima facie obvious to incorporate the above teachings of McFiggans in order to automatically feed back information on undelivered mail (as taught by McFiggans, col. 2, line 60).

23. As per claims 20 and 27, Montgomery in view of Whitehouse and McFiggans teaches the methods of claims 19 and 26 as described above. Montgomery further teaches the expected package period is one period selected from the group of one day, one week, one month and six months (§ 0169).

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628